

REMARKS

Status of the Claims

Claims 16 and 17 are pending. Both claim 16 and claim 17 are independent.

Applicant has amended claims 16 and 17 to specify that the portion of a face depicted by at least some of the templates consists of less than the entire face, and that the simulated facial image has a substantially complete face. Applicant respectfully submits that these amendments are supported in the original disclosure, for example, in originally filed Fig. 10C. Accordingly, no new matter has been added.

In addition, Applicant has also amended claims 16 and 17 to specify that the templates depict a portion of a face having a simulation of use of a beauty product other than a scalp hair coloring product. Applicant respectfully submits that this language is also supported in the original specification, since, the original specification indicates many other possible beauty products (besides hair colorings) that may be simulated. (See para. [043] and M.P.E.P. § 2173.05(i) ("If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.")). Therefore, no new matter has been added.

Office Action

Claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Orpaz et al. (U.S. 6,937,755) in view of Marapane et al. (WO 01/87245). Claims 16 and 17 are also rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Marapane in view of Mase et al. (U.S. Patent No.

5,491,777).¹ In addition, claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Orpaz in view of Mase.

Rejection Under § 103(a) Based on Orpaz and Marapane

Applicant respectfully submits that the rejection of claims 16 and 17 under 35 U.S.C. § 103(a) based on Orpaz and Marapane should be withdrawn because the applied references do not disclose or suggest all of the features recited in independent claims 16 and 17.

The Examiner acknowledges that “Orpaz does not teach that said associated appearance (a simulation of use) information for the product is displayed simultaneously with said beauty product and a color option of said product.” (Office Action at 3, emphasis added.) While it is not exactly clear what is meant by this language in the Office Action, this language appears to be derived from the language in the Board Decision of October 15, 2009. Specifically, the Board held that

[w]e agree with the Appellant. The Examiner appears to use inconsistent findings as to what constitutes the templates. At Answer 13, where the Examiner explains how Orpaz describes claim 1, the Examiner first finds that the category list is the set of templates and later finds that the make up application areas on the central picture are the templates.

¹ The rejection statement on page 3 of the Office Action reads “Claims 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,937,755) Marapane et al. in view of Marapane et al. and further in view of Mase et al. (US 5,491,777).” Applicant notes that the rejection statement lists “Marapane” twice and lists the patent number for Orpaz without actually listing Orpaz. Since the discussion on page 4 following the rejection statement on page 3 does not mention Orpaz, and since Orpaz and Marapane are combined in the previous rejection on page 2, Applicant believes the rejection on page 3 was intended to be based on a combination of Marapane and Mase, and not based on Orpaz. Applicant has prepared this response under the assumption that this rejection applies Marapane and Mase only. If Applicant’s assumption is incorrect, Applicant invites the Examiner to clarify the grounds of rejection and respectfully requests that any subsequent office action be non-final.

Apparently this is because it is the category list that is selected from and it is the make up application area that simulates the beauty product.

Claim 1 clearly requires that the template selected be the one in the simulation, however. The Examiner has not presented any findings in which this simultaneity occurs. We conclude the Examiner has erred in finding that Orpaz anticipates claim 1. Independent claim 18 has limitations similar to claim 1 and the Examiner similarly erred in its rejection.

(Board Decision at 16, emphasis added.) With regard to Orpaz, the Board agreed with Applicant's contention that Orpaz does not disclose a plurality templates and a simulated facial image, wherein the plurality of templates AND the simulated facial image depict a portion of a face having a simulation of use of a beauty product. This is the simultaneity to which the Board refers, i.e., that both the templates and the simulated facial image include a portion of a face. Applicant respectfully submits that only the large facial image in Orpaz's Fig. 3 depicts a portion of a face, and thus, Orpaz does not disclose or suggest "a plurality of templates, wherein at least some of the templates depict a portion of a face consisting of less than an entire face," as recited in claims 16 and 17. The Office Action further acknowledges that "Orpaz does not teach that said displaying said templates includes displaying said associated appearance (a simulation of use) information for the product." (Office Action at 5.)

In an attempt to cure these deficiencies of Orpaz, the Office Action relies on Marapane for an alleged teaching of "a plurality of templates depicting a simulation of use of a beauty product . . . presented to the consumer so that the consumer can select a desired template and the final output— a simulated facial image of the consumer is presented on a screen." (Office Action at 3.) However, Marapane does not disclose

facilitating display, on a display device, of a plurality of templates, wherein at least some of the templates depict a portion of a face consisting of less than the entire face, the portion of the face having a simulation of use of a beauty product other than a scalp hair coloring product;

enabling selection of at least one of the displayed templates;
and

facilitating display, on the display device, of a simulated facial image having a substantially complete face,

as recited in claims 16 and 17. (Emphasis added.)

Marapane discloses a number of thumbnail images of a subject's entire face with varying shades of hair color from which to choose. (See Fig. 9.) Marapane does not disclose or suggest templates depicting a portion of a face consisting of less than the entire face, the portion of the face having a simulation of use of a beauty product other than a scalp hair coloring product," as recited in amended claims 16 and 17. In Marapane, the rendered image 335 (see Fig. 15) that is created based on the selected thumbnail does not include a "simulation of [a] displayed facial portion [that] corresponds to a simulation of the at least one selected template," as required by claims 16 and 17. As specified in the first clause following the preamble in both claim 16 and claim 17, at least some of the templates include a simulation of "use of a beauty product other than a scalp hair coloring product." However, in Marapane, only the hair portion of the subject's image is taken from the selected thumbnail and applied to the rendered image 335. See Fig. 15; page 10, lines 5-14, and page 12, line 13. As shown in Fig. 15, no facial portion from the thumbnails is applied to the rendered image 335, and thus, the rendered image does not include a simulation of a displayed facial portion that

corresponds to a simulation of the at least one selected template, as required by claims 16 and 17.

Further, the Examiner acknowledges, at page 4 of the Office Action, that “Marapane does not explicitly teach that said templates are representative of a portion of a face.” Since, as noted above, Orpaz also fails to disclose or suggest “a plurality of templates wherein at least some of the templates depict a portion of a face,” neither Marapane nor Orpaz discloses or suggests this claimed feature, and thus, a prima facie case of obviousness cannot be established.

For at least these reasons, Applicant respectfully submits that the § 103(a) rejection of claims 16 and 17 based on Orpaz and Marapane should be withdrawn.

Rejection Under § 103(a) Based on Marapane and Mase

Applicant respectfully submits that the rejection of claims 16 and 17 under § 103(a) based on Marapane and Mase should be withdrawn because the cited art does not disclose or suggest all of the features recited in independent claims 16 and 17.

The Office Action acknowledges that “Marapane does not explicitly teach that said templates are representative of a portion of a face.” (Office Action at 4.) In an attempt to cure this acknowledged deficiency, the Office Action relies on Mase.

However, as noted above, Marapane also fails to disclose or suggest

facilitating display, on a display device, of a plurality of templates, wherein at least some of the templates depict a portion of a face consisting of less than the entire face, the portion of the face having a simulation of use of a beauty product other than a scalp hair coloring product;

enabling selection of at least one of the displayed templates;
and

facilitating display, on the display device, of a simulated facial image having a substantially complete face,

as recited in amended claims 16 and 17. (Emphasis added.) Applicant respectfully submits that Mase fails to cure at least some of these deficiencies of Marapane. For example, Mase does not disclose “a plurality of templates, wherein at least some of the templates depict a portion of a face . . . having a simulation of use of a beauty product ,” as recited in claims 16 and 17. Mase discloses an image data processing device configured to allow a user to create a composite image using different-looking facial features (see Fig 3A). However, there is no disclosure of a “portion of the face . . . having a simulation of use of a beauty product,” as required by claims 16 and 17. Accordingly, the Examiner’s proposed combination of Marapane and Mase fails to disclose or suggest all of the claimed features of claims 16 and 17.

For at least these reasons, Applicant respectfully submits that the § 103(a) rejection based on Marapane and Mase should be withdrawn.

Rejection Under § 103(a) Based on Orpaz and Mase

The § 103(a) rejection of claims 16 and 17 based on Orpaz and Mase should be withdrawn because the applied references do not disclose or suggest all of the features recited in independent claims 16 and 17.

The Office Action acknowledges that “Orpaz does not teach that said displaying said templates includes displaying said associated appearance (a simulation of use) information for the product.” (Office Action at 5.) In addition, as discussed above, Orpaz has other deficiencies with respect to amended claims 16 and 17.

In an attempt to cure the deficiencies of Orpaz, the Office Action relies on Mase. However, Applicant respectfully submits that, as discussed above, Mase, like Orpaz, fails to disclose or suggest “a plurality of templates, wherein at least some of the templates depict a portion of a face . . . having a simulation of use of a beauty product ,” as recited in amended claims 16 and 17. Since neither Orpaz nor Mase discloses or suggests this feature of claims 16 and 17, no prima facie case of obviousness can be established based on these references.

For at least these reasons, Applicant respectfully submits that the § 103(a) rejection based on Orpaz and Mase should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that each of independent claims 16 and 17 is allowable over the cited art.

The Office Action contains a number of statements reflecting assertions and/or allegations concerning the claims and/or cited art. Regardless of whether any such statement is identified above, Applicant declines to subscribe to any assertion or allegation in the Office Action.

Applicant respectfully requests reconsideration of this application and the timely allowance of claims 16 and 17.

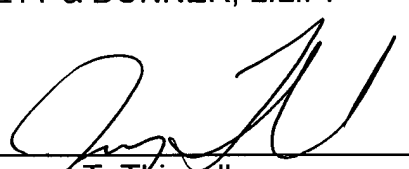
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: January 15, 2010

By: _____


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